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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,371	09/20/2000	Davi Geiger	24147.00	6163
30873	7590	11/28/2006	EXAMINER	
DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT 250 PARK AVENUE NEW YORK, NY 10177			ABDULSELAM, ABBAS I	
			ART UNIT	PAPER NUMBER
			2629	

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/666,371	Applicant(s) GEIGER ET AL.	
	Examiner Abbas I. Abdulsalam	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 and 31-42 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 36,37,40 and 42 is/are allowed.
- 6) ☒ Claim(s) 1-29,31-35,38,39 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments filed on 09/06/06 have been fully considered but they are not persuasive.

Applicant argues that claims 1-29, 31-35, 38-39 and 41 are not to be rejected under 35 U.S.C. 101. Applicant also argues that the claims are fully compliant with 35 U.S.C. 101 and cites several case laws in support of the argument. However, the examiner maintains the rejection based on the current USPTO examination guidelines, which are based on current understanding of law and are believed to be consistent with binding precedent of the courts. Accordingly, given the absence of any practical effect or significant independent physical acts, applicant's claims fail to adequately define the claimed invention within the domain of patentable subject matter.

Allowable Subject Matter

2. Claims 36-37, 40 and 42 are allowed.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-29, 31-35, 38-39 and 41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 recites "a method of segmenting input data representing an image in order to locate a part of said image...". Claims 15, 20, 22-23, 26, 31 and 33 recite "a method for

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associating particular data in a space....". Claim 34 recites "a system of segmenting input data representing an image in order to locate a part of said image...". Claims 35 and 41 recite "a system for associating particular data in a space....". In all of the above claims, applicant has recited steps that do nothing more than manipulate basic mathematical constructs, hence the claims are unpatentable. See *In re Warmerdam*, 33 F.3d 1354, 1360 (Fed. Cir 1994).

Patentable subject matter is held to exclude "laws of nature, natural phenomena, and the abstract ideas". *Diamond V. Diehr*, 450 U.S. 175, 185, 101 S.Ct 1048, 1056 (1981). Applicant's claims start with steps of manipulating abstract ideas and proceed to generate other abstract ideas. Only an applicant's claims are entitled the protection of the patent system, therefore claims, if expressing ideas in a mathematical form, must describe something beyond the manipulation of ideas in order to qualify as patentable subject matter. *In re Warmerdam*, at 1360. Given the absence of any practical effect or significant independent physical acts, Applicant's claim fail to adequately define the claimed invention within the domain of patentable subject matter.

Claims 2-14, 16-19, 21, 24-25, 27-29, 32, and 38-39 are similarly rejected as their respective independent claims. Each of these claims provides further refinements of the method, or the system, but none of the claims include any limitations that provide some practical effect of the method or system, which would avoid a rejection for lack of statutory subject matter.

Applicant may be able to overcome Examiner's rejections by amending the claims to encompass statutory subject matter. If an applicant were to include language in the claims, which indicates some practical effect of the performance of the method or the operation of the apparatus, the examiner believes such an amendment would overcome the 101 rejection.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abbas I. Abdulsalam whose telephone number is 571-272-7685. The examiner can normally be reached on Monday through Friday from 9:00 A.M. to 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Abbas Abdulsalam

Examiner

Art Unit 2629

November 23, 2006



RICHARD HJERPE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600